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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,381	05/30/2006	Kilian Krettenauer	LA-7688-101/10506074	6784
167 7590 09/16/2009 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071			EXAMINER ZIMMERMAN, JOHN J	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 09/16/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,381	Applicant(s) KRETTENAUER, KILIAN	
	Examiner John J. Zimmerman	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-92 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 31-92 is/are rejected.
- 7) ☒ Claim(s) 32-55, 57-80, 82, 83, 85, 86, 88, 89, 91 and 92 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/13/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050613, 20070117, 20080215</u> . | 6) <input type="checkbox"/> Other: ____. |

FIRST OFFICE ACTION

Amendments

1. The claims in this application were introduced in the correspondence titled "FIRST PRELIMINARY AMENDMENT" received June 13, 2005. Claims 1-30 were canceled and new claims 31-92 were introduced.

Priority

2. A copy of the German foreign priority document has been received in this application.

Information Disclosure Statement

3. The information disclosure statements received June 13, 2005 and January 17, 2007 and February 15, 2008 have been considered.

Drawings

4. The drawings filed in this application are not objected to.

Specification

5. The disclosure is objected to because of the following informalities: Headings (e.g. "Brief Description of the Drawings", "Summary of the Invention", "Detailed Description of the Invention", etc. . .) should be inserted into the specification. Appropriate correction is requested.

Claim Objections

6. Claims 32-55, 57-80, 82-83, 85-86, 88-89 and 91-92 are objected to under 37 CFR 1.75(c), as being of improper dependent form for depending on canceled claims. *Since these claims depend on canceled claims, their limitations cannot be determined and therefore they have not been further treated on the merits with regards to prior art in the rejection under 35 U.S.C. 103(a) below.*

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 55 and 80 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 32-55, 57-80, 82-83, 85-86, 88-89 and 91-92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 32-55, 57-80, 82-83, 85-86, 88-89 and 91-92 are indefinite since these claims depend on canceled claims and thus their limitations cannot be determined.

12. Claims 55 and 80 provide for the "use" of a metal element, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a "use" without any active, positive steps delimiting how this use is actually practiced. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

13. The term "in particular" is indefinite in a claim since it is not clear if the limitations after the phrase are required by the claim or merely suggestive (e.g. see claims 43, 48, 49, 68, 73, 78, 79, 83, 86, 89 and 92). In addition, the use of "in particular" to establish a narrower range together with a broader range is indefinite. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. &

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Inter. 1989), as to where broad language is followed by "such as" and then narrow language.

The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 31, 56, 81, 84, 87 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirey (U.S. Patent 4,545,170).

16. Shirey discloses a metal sheet element (e.g. Figure 8) having a surface which extends from a first outside edge (51) to an opposite second outside edge (52) and having several completely bordered apertures and also having a central region with outwardly disposed part sections being folded over (71-74). Shirey appears to show the configurations required by rejected claims, but if Shirey is deficient in showing a specific configurational detail, it should be noted that the basic inventive concept of forming a metal element in this fashion is clearly

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disclosed by Shirey and no convincing evidence of record shows that any claimed configurational differences are anything more than ones of numerous patentably indistinct configurations a person of ordinary skill in the art would find obvious for this same purpose, *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP 2144.04(IV). Regarding the method claims, operations such as bending and folding are disclosed by Shirey (e.g. column 4, lines 19-59) and it also would have been obvious to one of ordinary skill in the art at the time the invention was made to use any proven conventional cutting method, e.g. rotary, laser, etc. . . , to produce the cuts in the web of Shirey because such conventional cutting apparatuses are proven for this purpose and are readily available in a standard sheet metal forming facility.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional prior art made of record serves to further establish the level of ordinary skill in the art.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John J. Zimmerman
Primary Examiner
Art Unit 1794

/John J. Zimmerman/
Primary Examiner, Art Unit 1794

jjz
September 11, 2009